UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,532	08/15/2003	Robert L. Rae	18279-14445	2923

758 7590 09/09/2009

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER	
SHAH, ANTIM G	
ART UNIT	PAPER NUMBER
2614	

MAIL DATE	DELIVERY MODE
09/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/642,532	RAE, ROBERT L.	
	Examiner	Art Unit	
	ANTIM SHAH	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,12-13,15,17-22,25,32,40-42,59,62,63,71 and 96-98* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,12-13, 15, 17-22, 25, 32, 40-42, 59, 62-63, 71 and 96-98* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/12/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicants' amendment filed on 5/12/2009 has been entered. Claim(s) 1, 12-13, 15, 17-22, 25, 32, 40-42, 59, 62-63, and 96-98 has/have been amended. Claim 3 have been canceled. No new claims have been added. Claims 1, 12-13, 15, 17-22, 25, 32, 40-42, 59, 62-63, 71 and 96-98 are still pending in this application, with claims 1 and 59 being independent.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims **1, 12-13, 15, 17-22, 25, 32, 40-42, 59, 62-63, 71 and 96-98** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites new limitations: "a call application management system connected to the networking device and the unauthorized call activity detection system for at least processing the **first VoIP data packets** from the multiple prison facilities into **first call signals** and transmitting first call signals to a **first telephone carrier network** the call application management system receiving second call signals from the first telephone carrier network and processing the **second call signals into the second**

VoIP data packets for distribution to the multiple prison facilities by the networking device" and "a call application management system connected to the networking device and the unauthorized call activity detection system for at least processing the **first VoIP data packets** from the multiple prison facilities into **first call signals** and transmitting **first call signals** to a first telephone carrier network the call application management system receiving **second call signals** from the first telephone carrier network and processing the **second call signals** into the **second VoIP data packets** for distribution to the multiple prison facilities by the networking device". The examiner can not find support for this new limitations. Specifically, there is no mention of "first VoIP data packets", "first call signals", "second call signals", "second VoIP data packets". Similar limitations recite in amended claim 59. Claims 12-13, 15, 17-22, 25, 32, 40-42, 62-63, 71 and 96-98 are directly or indirectly depending on claims 1 and 59. Therefore, they have been also rejected.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 1, 3, 12, 13, 15, 17-20, 22, 32, 42, 59, 62, 63, 71 and 96-98** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No.

2007/0041545 to *Gainsboro* ("*Gainsboro*") in view of U.S. Patent Publication No 2003/0091028 to *Chang* et al. ("*Chang*").

As to **claim 1**, *Gainsboro* discloses a centralized call processing system for providing call processing services to multiple prison facilities [paragraph 0067, Fig. 1], comprising:

a networking device connected via digital data links to call processing at the multiple prison facilities, at least one of the multiple prison facilities located remotely from the call processing system [paragraphs 0067, 0073, Fig. 1-2, FTS central offices];

an unauthorized call activity detection system connected to the networking device for detecting unauthorized call activity associated with the calls to or from one or more of the multiple telephone terminals [paragraphs 0035, 0037, 0776-0788]

a call application management system connected to the networking device and the unauthorized call activity detection system for at least processing the first VoIP data packets from the multiple prison facilities into first call signals and transmitting first call signals to a first telephone carrier network the call application management system receiving second call signals from the first telephone carrier network and processing the second call signals into the second VoIP data packets for distribution to the multiple prison facilities by the networking device [paragraphs 0034-0037, 0074, 0838, Fig. 2, FMU is integrated

with ITS-II components which includes call processing, call monitoring, IVR equipments].

Gainsboro does not expressly disclose gateways to collect first Voice over Internet Protocol (VoIP) data packets associated with calls and to distribute second VoIP data packets associated with the calls to the multiple facilities. Even though, *Gainsboro* teaches internet technology and PCOF network [0315, 0690-0692]. It is extremely obvious and well known in the art to use VoIP to make voice calls over internet.

In the same or similar fields of endeavor, *Chang* discloses gateways to collect first Voice over Internet Protocol (VoIP) data packets associated with calls and to distribute second VoIP data packets associated with the calls to the multiple facilities [*Chang* Abstract, Fig. 3, 3A, 5, paragraphs 0085-0089, 0141].

It would have been obvious to the person of ordinary skill in the art at the time of the invention to modify *Gainsboro* to have the gateways to collect first Voice over Internet Protocol (VoIP) data packets associated with calls and to distribute second VoIP data packets associated with the calls to the multiple facilities as taught by *Chang*. The suggestion/motivation would have been to provide a highly integrated voice gateway system for use within a company which can route a voice call between parties at two different locations over IP network [*Chang* paragraph 0016].

As to **claim 12**, *Chang* discloses wherein said call processing gateways comprise voice over Internet protocol gateways [*Chang* paragraph 0015, 0085, 0141].

As to **claim 13**, *Chang* discloses wherein each of said call processing gateways provide at least one local area network interface for coupling with a computer workstation [*Chang* paragraph 0034, 0079].

As to **claim 15**, *Chang* discloses wherein said call application management system communicates with said first telephone carrier network using digital data packets [*Chang* paragraph 0016, 0100, 0141, IP network].

As to **claim 17**, *Chang* discloses a media gateway connected to the networking device for placing said calls on said first telephone carrier network using analog signals [*Chang* paragraphs 0016, 0037, 0043, 0079-0080].

As to **claim 18**, *Gainsboro* discloses call recording system [*Gainsboro* paragraph 0002, 0036, 0054].

As to **claim 19**, *Gainsboro* discloses a billing system, connected to said call application management system for providing real-time call accounting [*Gainsboro* paragraphs 0068-0069, 0082, 0306].

As to **claim 20**, *Gainsboro* discloses a validation system connected to said call application management system for authorizing connecting of said calls to said first telephone carrier network [*Gainsboro* paragraphs 0131, 0237].

As to **claim 22**, *Gainsboro* teaches whether a call forwarding feature is activated for call numbers associated with the calls [*Gainsboro* paragraphs 0037, 0135, 0777, 0782-0784].

As to **claim 32**, *Gainsboro* discloses interactive voice response functionality for providing messaging associated with processing of the calls [*Gainsboro* paragraph 0838].

As to **claim 42**, *Chang* discloses wherein said first carrier network comprises the PSTN (Public Switched Telephone Network) [*Chang* paragraphs 0016, 0037, PST network].

As to **claim 59**, *Gainsboro* discloses a method for processing calls for multiple facilities, the method carried out in a call processing system, the method comprising [paragraph 0067, Fig. 1]:

collecting first Voice over Internet Protocol (VoIP) data packets associated with calls from the multiple prison facilities via digital data links, at least one of the multiple prison facilities located remotely from the call processing system [paragraphs 0067, 0073, Fig. 1-2, FTS central offices], each of the multiple facilities including multiple telephone terminals [0067, 0074 "plurality of inmate telephone stations];

processing the first VoIP data packets from the multiple prison facilities into call signals for transmission over a telephone carrier network column 11 lines 10-61, column 14 lines 39-64]; processing second call signals from the telephone carrier network into second VoIP data packets [paragraphs 0034-0037, 0074];

detecting unauthorized three-way call activity associated with the calls [paragraphs 0035, 0037, 0776-0788]; and distributing the second VoIP data packets associated with the calls to the multiple prison facilities via the digital data links [paragraphs 0034-0037, 0074].

Gainsboro does not expressly disclose processing first Voice over Internet Protocol (VoIP) data packets associated with calls and to distribute second VoIP data packets associated with the calls to the multiple facilities. Even though, *Gainsboro* teaches internet technology and PCOF network [0315, 0690-0692]. It is extremely obvious and well known in the art to use VoIP to make voice calls over internet.

In the same or similar fields of endeavor, *Chang* discloses processing collect first Voice over Internet Protocol (VoIP) data packets associated with calls and to distribute second VoIP data packets associated with the calls to the multiple facilities [*Chang* Abstract, Fig. 3, 3A, 5, paragraphs 0085-0089, 0141].

It would have been obvious to the person of ordinary skill in the art at the time of the invention to modify *Gainsboro* to have processing collect first Voice over Internet Protocol (VoIP) data packets associated with calls and to distribute second VoIP data packets associated with the calls to the multiple facilities as taught by *Chang*. The suggestion/motivation would have been to provide a highly integrated voice gateway system for use within a company which can route a voice call between parties at two different locations over IP network [*Chang* paragraph 0016].

As to **claim 62**, *Chang* discloses the method of claim 59, further comprising: coupling said call processing platform to the telephone carrier network via an analog interface [*Chang* paragraphs 0016, 0037, 0043, 0079-0080].

As to **claim 63**, *Chang* discloses the method of claim 59, further comprising: coupling said call processing platform to the telephone carrier network via a digital interface [*Chang* paragraph 0016, 0100, 0141].

As to **claim 71**, *Gainsboro* discloses recording the calls from the multiple telephone terminals [*Gainsboro* paragraphs 0002, 0036, 0038-0039, 0054, 0818]; and analyzing content of the calls for particular utterances to determine presence of threats in the calls [*Gainsboro* paragraphs 0052, 0421].

As to **claim 96**, *Chang* discloses wherein the call application management system is further configured to process and transmit first call signals from the multiple telephone terminals to a second telephone carrier network, the call application management system selecting either the first telephone carrier network or the second telephone carrier network to transmit the call signals [*Chang* paragraphs 0016, 0143-0162]. As per *Chang,* Gateway network provides capability to place telephone call to a PST network via IP network and vice-versa.

As to **claim 97**, *Chang* discloses wherein the call application management system establishes connection for the calls over the first telephone carrier network and switches to connection over the second telephone carrier network

responsive to detecting a predetermined event [paragraphs 0163-0176, "fallback to PST network].

As to **claim 98**, *Chang* discloses the method of claim 59, further comprising: selecting one telephone carrier network among multiple telephone carrier networks connected to the call processing platform for processing and transmission of the calls responsive to receiving the calls from the multiple telephone terminals [*Chang* paragraphs 0016, 0143-0162, PBX has multiple terminals]. As per *Chang,* Gateway network provides capability to place telephone call to a PST network via IP network and vice-versa].

6. **Claims 21 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gainsboro* and *Chang* (as applied above) in further view of U.S. Patent No. 7,333,798 to *Hodge* ("*Hodge*").

As to **claim 21**, *Gainsboro* and *Chang* teaches everything claimed, as applied to claim 1, with the exception of a justice application management system and a commerce system for managing commissary orders placed by the inmates.

In the same field of endeavor, *Hodge* teaches the justice application management system [*Hodge* col. 21 lines 48-60] and a commerce system for managing commissary orders placed by the inmates [*Hodge* column 6 lines 33-49].

It would have been obvious to the person of ordinary skill in the art at the time of the invention to modify *Gainsboro* and *Chang* to have the justice

application management system as taught by *Hodge*. The suggestion/motivation would have been to identifying and authenticating an institutional calling party [*Hodge* column 9 lines 54-61].

As to **claim 25**, *Hodge* teaches wherein said justice application management system further provides investigative information with respect to said calls [*Hodge* col. 21 lines 48-60].

7. **Claims 40-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gainsboro* and *Chang* (as applied above) in further view of U.S. Patent No. 6,985,478 to *Pogossiants et al.* ("*Pogossiants*").

As to **claim 40**, *Gainsboro* and *Chang* teaches everything claimed, as applied to claim 1, with the exception of wherein said first carrier network comprises a SIP (Session Initiation Protocol) carrier. Even though, Chang teaches VoIP using H.323 protocol. It is extremely obvious and well known in the art to use SIP protocol.

In the same field of endeavor, *Pogossiants* discloses first carrier network comprises a SIP (Session Initiation Protocol) carrier [column 3 lines 29-35].

It would have been obvious to the person of ordinary skill in the art at the time of the invention to modify *Gainsboro* and *Chang* to have SIP protocol as taught by *Pogossiants*. The suggestion/motivation would have been to have peer to peer signaling flexible protocol such as SIP in VoIP to create, terminate and modify sessions between peers.

As to **claim 41**, *Pogossiants* discloses wherein said first carrier network comprises a MGCP (Media Gateway Control Protocol) carrier [column 3 lines 29-35, column 19 lines 26-39].

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. **Claims 1 and 59** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7, 505, 406 to *Spadaro* et al ("*Spadaro*").

As to **claim 1**, *Spadaro* discloses a centralized call processing system for providing call processing services to multiple prison facilities [Fig. 3-6, column 3 line 50-column 5 line 2], comprising:

a networking device connected via digital data links to call processing gateways at the multiple prison facilities to collect first Voice over Internet Protocol (VoIP) data packets associated with calls from the multiple prison facilities and to distribute second VoIP data packets associated with the calls to the multiple prison facilities, at least one of the multiple prison facilities located remotely from the call processing system [Fig. 3-6, column 3 lines 50-57, column 4 lines 4-65];

an unauthorized call activity detection system connected to the networking device for detecting unauthorized call activity associated with the calls to or from one or more of the multiple telephone terminals [column 4 lines 4-65, "three way call detection 30a]; and

a call application management system connected to the networking device and the unauthorized call activity detection system for at least processing the first VoIP data packets from the multiple prison facilities into first call signals and transmitting first call signals to a first telephone carrier network the call application management system receiving second call signals from the first telephone carrier network and processing the second call signals into the second VoIP data packets for distribution to the multiple prison facilities by the networking device [Fig. 3-6, column 3 lines 50-57, column 4 lines 4-65].

As to **claim 59**, *Spadaro* discloses a method for processing calls for multiple prison facilities, the method carried out in a call processing system, the method comprising [Fig. 3-6, column 3 line 50-column 5 line 2]:

collecting first Voice over Internet Protocol (VoIP) data packets associated with calls from the multiple prison facilities via digital data links, at least one of the multiple prison facilities located remotely from the call processing system each of the multiple facilities including multiple telephone terminals [Fig. 3-6, column 3 lines 50-57, column 4 lines 4-65]

processing the first VoIP data packets from the multiple prison facilities into call signals for transmission over a telephone carrier network [Fig. 3-6, column 3 lines 50-57, column 4 lines 4-65];

processing second call signals from the telephone carrier network into second VoIP data packets [Fig. 3-6, column 3 lines 50-57, column 4 lines 4-65];

detecting unauthorized three-way call activity associated with the calls [column 4 lines 4-65, "three way call detection 30a]; and

distributing the second VoIP data packets associated with the calls to the multiple prison facilities via the digital data links [Fig. 3-6, column 3 lines 50-57, column 4 lines 4-65].

Response to Arguments

10. Applicant's arguments filed on 05/12/2009 with respect to claims 1, 12, 13, 15, 17-22, 25, 32, 40-42, 59, 62, 63, 71, 96-98 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTIM SHAH whose telephone number is (571)270-5214. The examiner can normally be reached on Monday to Friday 7:30 am-5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571)272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./
Examiner, Art Unit 2614

/Ahmad F Matar/
Supervisory Patent Examiner, Art Unit 2614